REMARKS/ARGUMENTS

Applicant acknowledges receipt of the Office Action dated 12/02/05. Claims 1-3, 7-12, 14-16 and 19-25 are pending in the application and are presented for reconsideration and further examination in view of the foregoing amendments and the following remarks and arguments.

By this Response and Amendment claims 1 and 7 have been amended. The rejections of claims 1-3, 7-12, 14-16 and 19-25 under 35 U.S.C. § 103(a) are respectfully traversed; and withdrawal of the objections to claims 2, 3 and 7 is respectfully requested.

AMENDMENT TO CLAIM 1

Claim 1 has been amended to change the term "step" to "act" to maintain consistency with the remaining base claims. Approval and entry are respectfully requested.

OBJECTION TO CLAIMS 2, 3, and 7

Claims 2 and 3 stand objected to under 37 C.F.R. § 1.75(c) as being improper for failing to further limit the subject matter of a previous claim. The objection is respectfully traversed.

Claim 1 sets forth claim elements as act "a" to "f" for purposes of reference. Claim 2 sets forth an additional act without reference letter, while claim 3 provides additional subject matter to act "e" of claim 1. M.P.E.P. § 2173.05(e) sets forth:

> ... The examiner's task of making sure the claim language complies with the requirements of the statute should be carried out in a positive and constructive way, so that minor problems can be identified and easily corrected ... Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.

Further, it is well settled that "[P]atentees are not required to claim each part of an invention with the same amount of detail; indeed such a rule likely would prove unworkable." Resonate Inc. v. Alteon Websystems, Inc., 338 F.3d 1360, 67 U.S.P.Q.2d 1771, 1775 (Fed. Cir. 2003). It is therefore respectfully submitted that recitation of an additional act in dependent claim 2 without

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recitation of an additional letter is within the purview of discretion afforded to the Applicant. Likewise, M.P.E.P. § 608.01(n) does not require such action. Claim 2 merely relates that the subject matter therein should be performed "prior to said act (e)." Claim 2 does not require omission or replacement of any prior claimed act.

It is further submitted that Applicant may present a dependent claim that sets forth additional subject matter directed to a particular act in a prior claim -- as provided by claim 3. Claim 3 does not require omission or replacement of any prior claimed act.

Claim 7 has been amended to remove the punctuation of ";" preceding the "." The undersigned wishes to thank the Examiner for pointing out this typographical error.

Reconsideration and withdrawal of the outstanding objection to claims 2, 3 and 7 is respectfully requested. In a spirit of cooperation, should the Examiner have any questions regarding the subject claims, the Examiner is invited to telephone the undersigned attorney at the number set forth below.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-3 and 20-22 were rejected under 35 U.S.C. §103(a) as obvious over US Patent 5,410,326 to Goldstein ("Goldstein") in view of US Patent 6,477,573 to Lea ("Lea").

Claims 7-12, 14-16, 19 and 23-24 were rejected under 35 U.S.C. §103(a) as obvious over Goldstein in view of Lea, and in further view of US Patent 6,314,572 to LaRocca et al. ("LaRocca").

Claim 25 was rejected under 35 U.S.C. §103(a) as obvious over Goldstein in view of Lea, and in further view of US Patent 6,490,726 to Harrison et al. ("Harrison").

Applicant respectfully traverses the rejections in accordance with the detailed arguments set forth below. Further consideration in view of the arguments is respectfully requested.

Claim 1 is directed to a method of programming a remote control device with data representative of a control code, which is downloaded from a dedicated server connected to a network, using a network connectable appliance as connecting means between the remote control

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device and the network. Applicant submits that the cited art references, either individually or in combination, do not disclose or suggest all the steps and limitations of the method claimed in claim 1 of the present application.

It is respectfully submitted that Goldstein does not teach "connecting a network connectable appliance to a dedicated server on the network" at Col. 4:11-26. Goldstein only discloses "including a telephone interface, either as part of the cable television converter or as part of the customer's telephone system", which allows to place a telephone call to a vendor or a service provider in response to an advertisement. Goldstein does not teach connecting an appliance to a dedicated server on the network, but merely providing an automated dialing interface for placing telephone calls.

It is also respectfully submitted that Goldstein does not teach "requesting, by the dedicated server via the network connectable appliance, alphanumeric information from the particular user, corresponding to the particular user's consumer electronics equipment, wherein said dedicated server request is made to said network connectable appliance" at Col. 15:41-44. Goldstein discloses a transaction over the telephone between a user and a prerecorded message system: "Following verification of a caller ID 114, the prerecorded message requests the zip code 115 of the caller, and the equipment list 116..." At Col. 4:44-48, Goldstein discloses that the caller submits that information "via the touch pad on the telephone" not "via the network connectable appliance" connected to a "dedicated server on the network", as claimed in claim 1 of the present application.

In Goldstein, the communication between a customer and a data base occurs *after* "the customer or point-of-sales retailer initiates a telephone call with the data base via a modem/telephone interface" (Col. 15:32-34), whereas claim 1 of the present application claims "connecting a network connectable appliance to a dedicated server on the network *in response to* the particular user controlling the particular user's remote control device."

The Office Action acknowledges that Goldstein does not teach step (d) of the method claimed in claim 1, i.e. Goldstein does not teach "performing a query, at the dedicated server, based on the alphanumeric information supplied by the particular user, to match the

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alphanumeric information supplied by the particular user with alphanumeric information stored in a data repository, **wherein the data repository relates types, versions and brands of consumer electronics equipment to their respective control codes.**" The Examiner relies upon Lea for this step of the method. Applicant submits that this reliance is misplaced since Lea does not disclose a data repository that relates types, versions and brands of consumer electronics to their respective control codes, and on which a query is performed based on alphanumeric information supplied by a particular user. Lea is directed to a system and method for performing a hierarchical remote query of a network in order to identify and pool software resources. The registry disclosed in Lea includes relevant information or attributes corresponding to the listed software elements. Lea's registry allows a software element to obtain a software element identifier for identifying and locating another software element in a network (Col. 6:27-40): "In the FIG. 4 embodiment, registry 412 may preferably include a listing of software elements in network software 316." Applicant therefore submits that Lea does not teach step (d) of the method of the present invention as claimed in claim 1.

Even if the "software elements" listed in Lea's registry were construed as "control codes" as the Examiner apparently does in the Office Action, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine their teachings in order to obtain the method of claim 1 with all its steps and limitations. Lea does in fact teach away from "a method of enabling a particular user to program the particular user's remote control device" because it is directed to an automated method for updating a plurality of software elements that work together in a network of electronics devices. The present invention requires a user's manual input, whereas Lea's purpose is to implement a method for managing communications between various software elements in a way that does not require any input from a user.

Furthermore, Applicant submits that combining Goldstein with Lea would not yield the method of the present invention as claimed in claim 1, even if there were any suggestion to do so. Combining "a user accessing a remote server by telephone in order to download a programming code for a remote control device" with "a software element querying a registry to

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locate other software elements in a network" does not yield the method of claim 1 wherein "a dedicated server is connected to an appliance in response to a particular user controlling a remote control device, an exchange of information occurs between the dedicated server and the user, and a query is performed at the dedicated server, to match the information supplied by the user with information stored in a data repository."

It is therefore submitted that claim 1, and dependent claims 2, 3, 10, and 19-25 are not obvious over the cited art references. Reconsideration and withdrawal of the obviousness rejection are respectfully requested.

Claim 7, as previously presented and hereby re-submitted, is directed to a system comprising, *inter alia*, a network connectable appliance configured to program a remote control device based on data received from a dedicated server, according to a user profile associated with the remote control device. This system is essentially configured to perform the method claimed in claim 1, and therefore Applicant incorporates herein by reference the arguments presented above in the response to the 103(a) rejections of claim 1 over Goldstein in view of Lea. Additionally, Applicant submits that combining LaRocca with Goldstein and Lea does neither anticipate nor suggest the system claimed in claim 7.

It is respectfully submitted that Goldstein does not teach that "control codes from said server are provided according to a user profile **associated with the remote control device.**" Goldstein actually discloses a remote control device including a touch screen display which **displays icons representing the various services** for which the user has subscribed (Col. 3:45-51). In other words, in Goldstein the information displayed by the remote control device is related to services, whereas in the system of claim 7 the information provided by the server is associated with the apparatus itself, not with the various services provided.

Further, Goldstein does not teach a remote control device "including means for causing the network connectable appliance to initiate a connection to the dedicated server on the network." Goldstein actually discloses "a telephone interface, either as part of the cable television converter, or as part of the customer's telephone system, [that allows] to place a call to

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respond to an advertisement" and also "a command is sent to the telephone interface to establish a connection with the service provider." In other words, Goldstein does not teach means for causing a connection between the appliance and a dedicated server, but merely an interface for automatic dialing of a phone number.

The Office Action acknowledges that Goldstein does not teach "a data repository comprising a plurality of user profiles" as claimed in claim 7 and relies upon LaRocca for this particular limitation. Here again, the information contained in the user profiles of the present invention is related to the remote control device itself, whereas LaRocca discloses profiles that only contains customer subscription information pertaining to a customer's type of service (Col. 5:29-40).

It is therefore submitted that claim 7 and dependent claims 8 and 9 are not obvious over the cited art references. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 11, 15 and 16 were rejected by the Examiner using the same grounds of rejections as for claim 7, and the Examiner stated that the same rationale of rejection used for claims 1 and 7 is applicable to claims 11, 15 and 16. Consequently, Applicant incorporates herein by reference the arguments presented above in the responses to the 103(a) rejections of claims 1 and 7, and submits that claims 11, 15 and 16 are allowable over the cited art references at least for the same reasons that claims 1 and 7 are allowable.

Accordingly, reconsideration and withdrawal of the rejection of claims 11, 15 and 16 is respectfully requested.

It is submitted that claims 12 and 14 are also allowable because they ultimately depend from claim 11, which is allowable over the cited art references based upon the above arguments. Accordingly, reconsideration and withdrawal of their rejections is respectfully requested.

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While we believe that the present application is now in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the undersigned attorney in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
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